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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,150	05/23/2000	Paul Lapstun	NPK004US.	9212

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AUSTRALIA

EXAMINER

SHIN, KYUNG H

ART UNIT PAPER NUMBER

2132

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,150

Applicant(s)

LAPSTUN ET AL.

Examiner

Kyung H Shin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

- This action is responding to application papers dated 5/23/2000.
- Claims 1 – 17 are pending. Claim 1 is independent claim.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. **Claims 1 - 17** are rejected under 35 U.S.C. 102(e) as being anticipated by Eldridge et al. (U.S. Patent No. 6,515,988; File date July 17, 1998).

Regarding Claims 1 and 9, Eldridge discloses in a network connected to a printer, a first server and a network terminal, a network terminal authorization protocol for

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authorizing the printing of a document at the printer at the request of the network terminal (see col. 2, lines 18 - 31), including the steps of:

- a) creating, at the first server (see col. 4, lines 6 - 14), an authorization record authorizing the network terminal to print at the printer; (see col. 5, lines 26 - 42)
- b) requesting, at the network terminal and via a printing request, printing of the document at the printer; (see col. 8, lines 48 - 58)
- c) verifying, using the authorization record, that the network terminal is authorized to print at the printer; and in the event that the verification succeeds, (see col. 9, lines 19 - 20)
- d) sending the document to the printer for printing. (see col. 9, line 35)

Regarding Claim 2, Eldridge discloses a protocol according to claim 1, wherein the requesting step, the printing request is sent to the first server, and the verifying and sending steps are performed at the first server. (see col. 11, lines 12 - 18)

Regarding Claim 3, Eldridge discloses a protocol according to claim 1, wherein the requesting step, the printing request is sent to a second server and the sending step is performed at the second server; the verifying step including the sub-steps of: (see col. 9, lines 13 - 21)

- a) requesting, at the second server and via a verification request sent to the first server, verification; and (see col. 9, lines 29 - 34)

- b) verifying, at the first server and in response to the verification request, that the network terminal is authorized to print at the printer. (see col. 9, lines 53 - 60)

Regarding Claim 4, Eldridge discloses a protocol according to claim 2 or claim 3, including the further steps of:

- a) allocating, at the network terminal, a public/private signature key pair; (see col. 2, lines 47 - 56)
- b) storing, at the network terminal, the private signature key; and (see col. 7, lines 13 - 15)
- c) storing, at the first server and as part of the authorization record, the public signature key. (see col. 2, lines 64 - 67)

Regarding Claim 5, Eldridge discloses a protocol according to claim 4, where the requesting step includes the sub-step of generating a digital signature using the private key (see col. 2, lines 47 - 50) and attaching it to the request (see col. 7, lines 49 - 54), and the verification step includes the sub-step of verifying the digital signature attached to the request using the public key. (see col. 3, lines 11 - 19)

Regarding Claim 6, Eldridge discloses a protocol according to claim 2 or claim 3, where the creating step includes the sub-step of storing, in the authorization record, a printer identifier identifying the printer (see col. 6, lines 1 - 5); the requesting step includes the sub-step of including, in the request, the printer identifier; and the verifying step includes the sub-step of verifying that the authorization record contains the same printer identifier as the request. (see col. 9, lines 50 - 60)

Regarding Claim 7, Eldridge discloses a protocol according to claim 6, where the creating step includes the sub-steps of:

- a) allocating a terminal identifier for the network terminal; (see col. 6, lines 48 - 62)
- b) storing the terminal identifier in the authorization record; and (see col. 7, lines 1 - 16)
- c) storing, at the network terminal, the terminal identifier. (see col. 1, lines 29 - 42)

Regarding Claim 8, Eldridge discloses a protocol according to claim 7, where the authorization record is retrievable by the printer identifier and terminal identifier stored therein. (see col. 7, lines 44 - 54)

Regarding Claims 10 and 11, Eldridge discloses a protocol according to claim 9, where the step of storing the authorization identifier includes the sub-step of

- a) storing expiry information relating to the authorization identifier; and the validating step includes the sub-step of (see col. 7, line 65 - col. 8, line 3)
- b) rejecting the authorization request if the expiry information indicates that the authorization request id has expired. (see col. 2, lines 57 - 60)

Regarding Claim 12, Eldridge discloses a protocol according to claim 2 or claim 3, where the requesting step includes the sub-step of including, in the printing request, the document. (see col. 7, lines 49-54)

Regarding Claim 13, Eldridge discloses a protocol according to claim 2 or claim 3, where the requesting step includes the sub-step of including, in the printing request, a document identifier of the document. (see col. 7, line 65 - col. 8, line 3)

Regarding Claim 14, Eldridge discloses a protocol according to claim 13, where the sending step includes the sub-step of retrieving the document using the document identifier. (see col. 9, lines 32-34)

Regarding Claim 15, Eldridge discloses a protocol according to claim 14, where the sending step includes the sub-step of formatting the document for printing. (see col. 10, lines 7-18)

Regarding Claim 16, x discloses a protocol according to claim 13, where the sending step consists of sending the document identifier to the printer. (see col. 9, lines 29-34)

Regarding Claim 17, Eldridge discloses a protocol according to claim 1, where the network terminal is Web browser running on a computer system. (see col. 5, line 1)

Conclusion

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Patent No.6,591,367 B1 to Kobata et al. discloses Method and Apparatus for Preventing Unauthorized Copying and Distributing of Electronic Messages Transmitted over a Network.
- b. U.S. Patent No.6,385,728 B1 to DeBry discloses System, Method, and Program for Providing Will-call Certificates for Guaranteeing Authorization for a Printer to Retrieve a File Directly from a File Server upon Request from a Client in a Network Computer system Environment.
- c. U.S. Patent No.6,314,521 B1 to DeBry discloses Secure Configuration of Digital Certificate for a Printer or Other Network Device.
- d. U.S. Patent No.6,505,238 to Tran discloses Method and System for Implementing Universal Login via Web Browser.
- e. U.S. Patent No.6,457,883 B1 to Silverbrook et al. discloses Interactive Printer Reward Scheme.
- f. U.S. Patent No.6,627,870 B1 to Lapstun et al. discloses Sensing Device with Interchangeable Nibs.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyung H Shin whose telephone number is 703-305-0711. The examiner can normally be reached on 6:30 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-2394.

K H S

Kyung H Shin
Patent Examiner
Art Unit 2132

KHS
December 23, 2003

Justin T. Darrow
JUSTIN T. DARROW
PRIMARY EXAMINER